

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application No.: 09/499,238
Filing Date: February 7, 2000
Applicant: Gregory A. Stobbs, et al.
Group Art Unit: 2741
Examiner: Leslie Wong
Title: COMPUTER-IMPLEMENTED PATENT PORTFOLIO
ANALYSIS METHOD AND APPARATUS
Attorney Docket: 9305-000002/US

Director of U.S. Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

The present Reply Brief is being submitted in the above-identified appeal in response the Examiner's Answer mailed April 27, 2010.

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Introduction and Summary of Reply Arguments

When confronted with a portfolio of patents, each patent potentially containing many claims, it is often difficult to surmise what the portfolio covers. One can, of course, read each patent claim, one-by-one, but that is like painting the Golden Gate Bridge. By the time you finish reading the last claim of the last patent, you have to start over again because the first claim read is no longer fresh in your mind.

The applicants' invention provides a solution to this problem in the form of a computer-implemented method and apparatus that associates a computer-generated claim breadth metric to the claim. The metric is useful, for example, in sorting the corpus of patents to allow the human reviewer to work more efficiently, focusing his or her attention on the potentially broad claims first.

Applicants applied for a patent on February 7, 2000, and claim priority to a provisional application filed February 5, 1999.

The Examiner lists in her Answer the evidence relied upon to comprise:

- Snyder (6,038,561),
- Risen (6,018,714),
- Petruzzi (6,049,811) and
- Rivette (6,339,767).

The Examiner applies Snyder, Risen and Petruzzi in rejecting all claims except dependent claim 17, to which the Rivette reference is also applied in combination with Snyder, Risen and Petruzzi.

It is applicants' position that the Examiner has not properly determined the scope and content of the prior art and has also failed to properly ascertain the differences between the claimed invention and the prior art. After failing to properly make the basic factual inquiries, the Examiner has additionally failed to provide a cogent rationale for the obviousness conclusion reached. Thus the Examiner's Answer does not state a *prima facie* case of obviousness under 35 U.S.C. § 103.

Legal Requirements for Obviousness Determination under 35 U.S.C. §103

The Supreme Court in *Graham v John Deere Co*, 383 U.S. 1, 148 USPQ 459 (1966), set forth the steps required to assess obviousness under 35 U.S.C. §103. Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

Objective evidence must be evaluated in making these factual inquiries. *Graham*, Id. At 17-18, 148 USPQ at 467.

The Supreme Court has more recently stated in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007), that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The court quoting *In re Kahn* stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational

underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at 418, 82 USPQ2d at 1396. “A fact-finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*...(warning against a ‘temptation to read into the prior art the teachings of the invention in issue’ and instructing courts to ‘guard against slipping into the use of hindsight’...)” *KSR*, 550 U.S. at 421.

Examiner erred in making underlying findings of fact upon which conclusion of obviousness was based

The Examiner made her factual finding based on Snyder (6,038,561), Risen (6,018,714), Petruzzi (6,049,811) and Rivette (6,339,767). Her conclusions of obviousness of all claims were based primarily on Snyder, Risen and Petruzzi. Rivette was used, in combination with the other three references, in rejecting dependent claim 17.

Snyder is not germane to applicants’ invention

Snyder teaches a text analysis system that uses computerized linguistic techniques to perform a “side-by-side textual analysis of matching patent claims.” (Snyder ‘561: col 4, lns 14-15). Presumably this type of analysis would be useful to identify two claims that would conflict in an interference proceeding, which is not germane to the applicants’ invention.

The Examiner admits that Snyder does not teach:

(b) automatically determining claim breadth metrics for the multiple claims by using computer to measure claim length;

(c) associating a claim breadth metric with a claim and storing said associated claim breadth metric in a computer-readable dataset; and

(d) wherein a claim breadth metric which is associated with a claim is indicative of how broad the claim is. [Examiner's Answer at page 5]

Risen is misconstrued by Examiner

Risen teaches assigning a monetary value to a patent based on human assessment. The Examiner admits that Risen does not teach:

(b) automatically determining claim breadth and using computer to measure claim length. [Examiner's Answer at page 6]

What the Examiner did not properly appreciate is that Risen applies the monetary value to the patent, *in gross*. Risen does not assign a value or other metric to an individual claim, as this quote from Risen relied upon by the Examiner demonstrates:

"... a value is then assigned to the patent. This value can be based, for example, upon the income and profits generated by the sale or use of the patented technology, the number of years remaining on the term of the patent, the breadth of the patent claims, the nature of competitive products or processes, etc." (Risen '714: col 9, lns 25-31).

Contrary to the Examiner's assertion, Risen does not teach or suggest that claim breadth metrics are applied *separately* to each individual claim. Indeed Risen is not concerned with performing a claim-by-claim analysis at all. Rather, Risen is simply concerned with applying a monetary value to each patent. If the human valuator considers the claims to be broad, a higher value (or lower value, if claims are *too* broad) might be assessed; but certainly there would be no reason to assess a value for each claim individually and Risen does not teach this.

In applicants' invention the "claim breadth metric" is associated with a claim and is indicative of how broad the claim is. See applicants' claim 1, last paragraph. Contrary to the Examiner's assertion, this is not found in the prior art, and certainly not in Risen.

Thus the Examiner has erred in determining the scope and content of the prior art as required by *Graham v. John Deere*.

Petruzzi is misconstrued by Examiner

The Examiner cites Petruzzi as teaching "automatically" and "using computer to measure claim length." [Examiner's Answer at page 6]. However, the Examiner errs in her factual inquiry regarding the scope and content of the prior art. Petruzzi does not teach "automatically determining claim breadth using computer to measure claim length," as the Examiner concludes. Indeed, Petruzzi has nothing to do with determining claim breadth.

Petruzzi teaches a patent application-drafting tool that uses a computer to count the number of words in a patent abstract, to assist the drafter in complying with the 250 word limit for the patent abstract.

The Examiner reasons that "if Petruzzi is able to count words from the patent Abstract, it should be able to count words in the patent claims as well." While that may be true, the Examiner's inference that *what is good for the abstract is good for the claims* is not warranted. The Examiner fails to demonstrate how knowledge that a computer can count words in a patent abstract (or patent claims for that matter) would lead one of skill in the art to modify the combination of Risen and Snyder to arrive at the applicants' invention. The Risen and Snyder combination, as described

by the Examiner, assigns human-curated monetary value metrics on a patent-by-patent basis. Using Petruzzi's technique of counting words would simply produce a word count. There would be no reason, in view of this evidence, to treat that word count as a monetary value metric (or any other metric for that matter).

To be clear, Petruzzi's word count of the Abstract is not a quality metric. Petruzzi is counting words simply because the USPTO rules specify that Abstracts shall be no more than 250 words, and not to generate a metric.

Thus again the Examiner has erred in determining the scope and content of the prior art as required by *Graham v. John Deere*.

Ascertaining the differences between prior art and claimed invention

As the foregoing has demonstrated, the Examiner did not properly perform the first step of the *Graham v John Deere* test of determining the scope and content of the prior art. Moreover, starting from these faulty factual findings the Examiner did not properly ascertain the differences between the prior art and the claimed invention. Thus, as will be shown below, the second step of the *Graham v John Deere* test has not been properly performed.

Examiner has admitted

The Examiner has admitted that Snyder does not teach:

(b) automatically determining claim breadth metrics for the multiple claims by using computer to measure claim length;

(c) associating a claim breadth metric with a claim and storing said associated claim breadth metric in a computer-readable dataset; and

(d) wherein a claim breadth metric which is associated with a claim is indicative of how broad the claim is. [Examiner's Answer at page 5]

The Examiner also has admitted that Risen does not teach:

(b) automatically determining claim breadth and using computer to measure claim length. [Examiner's Answer at page 6]

Examiner has not properly ascertained difference between prior art and claimed invention

Risen

The Examiner did not properly assess the difference between the applicants' invention and Risen in several respects. First, the Examiner appears to have ignored the claim recitation:

"wherein a claim breadth metric which is associated with a claim is indicative of how broad the claim is." [Applicants' claim 1]

By ignoring this limitation, the Examiner thus treats Risen's patent valuation metric as a claim breadth metric. When the actual teaching of Risen is considered, it is quite clear that Risen does not envision a claim breadth metric that is indicative of how broad the claim is:

"The second step of valuation of the intellectual property asset is the assignment of a monetary value to the intellectual property asset. For example, if the asset is a patent and if one or more claims of the patent are found to be valid and enforceable in the legal analysis, a **value is then assigned to the patent**. This value can be based, for example, upon the **income and profits** generated by the sale or use of the patented technology, the number of years remaining on the **term of the patent**, the **breadth of the patent claims**, the **nature of the patented technology**, the **nature of**

competitive products or processes, etc. One such method is described below in Prophetic Example 2. Other intellectual property assets can be assigned a monetary value in conventional ways by persons who specialize in, or have the skills needed, to value intellectual property. In another embodiment of the invention, the prospective purchaser of the intellectual property asset assigns their own value to the intellectual property, similar to the manner in which the U.S. Post Office allows a customer who purchases insurance for a parcel to select the desired amount of insurance coverage. While this latter valuation technique is simpler, it is likely to be more difficult to use in statistically determining an appropriate insurance premium.” [Risen ‘714: col 9, lns 20-43]

The applicants submit that a broadest reasonable interpretation of “claim breadth metric” cannot ignore the plain definition of that term provided in the body of the claim itself: “wherein a claim breadth metric which is associated with a claim is indicative of how broad the claim is.” Thus a patent valuation (per Risen) is not a claim breadth metric as recited in the claims.

Second, the Examiner also appears to have ignored the claim recitation:

“associating a claim breadth metric with a claim...” [Applicants’ claim 1]

By ignoring this limitation the Examiner thus treats Risen’s valuation metric as being associated with a claim, when in fact, the Risen valuation metric is associated with the entire patent, in gross.

Petruzzi

The Examiner likewise has failed to properly assess the differences between applicants’ invention and Petruzzi. The applicants’ claim 1 requires:

“automatically determining claim breadth metrics for the multiple claims by using computer to measure claim length.”

The Examiner read Petruzzi as “automatically” and “using computer to measure claim length,” but then ignored that the measured claim length is for determining claim breadth *metrics*.

Petruzzi is not counting words in the Abstract to generate a metric. Rather Petruzzi is counting words simply to check that the USPTO rule limiting an Abstract to 250 words is complied with. Thus the Examiner failed to acknowledge the important distinction that Petruzzi is not using the claims and is not generating claim breadth metrics.

No Articulated Reasoning or Cogent Rationale

The Supreme Court in *KSR* has made explicit that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusions of obviousness.” *KSR*, 550 U.S. at 418, 82 USPQ2d at 1396.

In this case the Examiner’s rationale amounts to the following conclusory statement:

“It would have been obvious to one of ordinary skill in the art of data processing to update the Valuator’s work in determining a value of an intellectual property asset as shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent drafting method as shown in **Petruzzi** to *keep pace with the current technology and to gain the commonly understood benefits of such adaptation, such as eliminate time-consuming, repetitive routine tasks and processes and providing a fast and more effective way to complete the task.*” [Examiner’s Answer page 7]

These recited platitudes provide no articulated reasoning whatsoever for combining and modifying the cited prior art to render applicants’ claims obvious. The Examiner’s reasoning has not addressed the fact that the Risen “valuation” is

applied *after* the human has read the claims and assessed the overall “breadth of the claims.” In assessing this value, it certainly does not follow that the human valuator would consider broad claims to always be more valuable. Indeed, overly broad claims may be readily invalidated by prior art and are therefore worthless. Thus to say that one would be moved to eliminate the task of reading the claim and assessing its value, based on the plethora of factors listed in the Snyder patent, and replace it with an automated word counting process makes no sense; and it certainly would not produce predictable results.

For obviousness to hold, there must be a reasonable expectation of success and predictable results; there cannot be a very large number of possibilities with no guidance for predicting the successful path forward. *Esai Co., Ltd. v. Dr. Reddy's Labs., Ltd.* 533 F.3d 1353 (Fed. Cir. 2008).

The Examiner cites *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 195 (CCPA 1958), in support of her rationale that applicants’ invention merely replaces a manual activity with an automated one.

However, *Venner* provides no shortcut. In *Ex parte Wollenberg*, Appeal 2009-010400, this Board held that:

“Neither the MPEP nor *Venner* supersedes the requirement to make a finding that the scope and content of the prior art included a reason to modify a known method.” *Ex parte Wollenberg* at 8-9.

In the present case, not only has the Examiner failed to properly determine the scope and content of the prior art, she has failed to provide a cogent reason why the prior art would be so modified. There simply is no good reason why one would

replace the human patent valuation function performed by Risen with an automated claim word counting operation à la Petruzzi, for such substitution would clearly not work.

In *Venner*, the difference between the claimed invention and the prior art was that the claimed invention used a footswitch-operated timer to open the molding apparatus, whereas the in prior art the human operator judged the time by himself. The *Venner* timer was set to elapse using the same time that the human operator would have used in the prior art. *Venner* the prior art timer was a human, and the claimed invention substituted a clock. The facts of the present case are not at all like *Venner* and *Venner* therefore does not apply.

The Examiner's Answer several times repeats the statement, unsubstantiated by evidence, that "counting the number of words in a claim to determine the breadth of the claim is well-known in the field of Patent claim drafting as the longer the length of the claim, normally, the narrower the scope of the claim and vice versa."

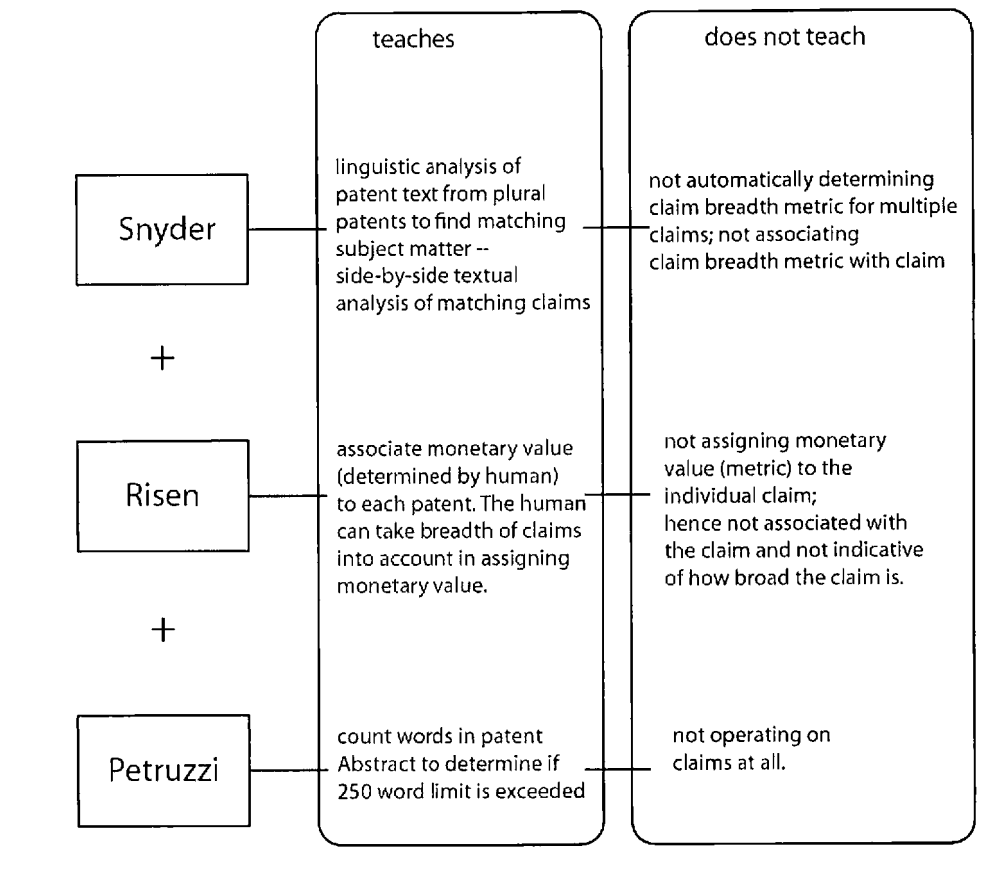
While the applicants refute this unsubstantiated statement as not supported by the record, the more important objection is this. The Examiner has provided no cogent reason or rationale why one of ordinary skill would use this purported knowledge to associate a claim breadth metric with a claim, store it in a computer-readable dataset and use it as an indicator of how broad the claim is.

Applicants submit that the Examiner does not have the proper prior art evidence to support the rejection under 35 U.S.C. § 103. What the Examiner instead has assembled is a patchwork of prior art references that cannot be sewn together by any cogent rationale.

Thus the Examiner has erred in failing to properly ascertain the differences between the claimed invention and the prior art as required by *Graham v. John Deere*.

To assist the Board in understanding the points raised in applicants' main brief and this reply brief, a visual summary of applicant's argument is provided on the following page.

Visual Summary of Applicants' Argument



≠ Does not equal ————— there is no teaching of:
 applicants' invention associating an automatically
 determined claim breadth metric
 with a claim, where the metric
 is indicative of how broad the
 claim is.

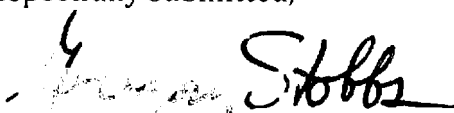
Conclusion

For the reasons discussed herein and in its opening Appeal Brief, Appellants respectfully submit that the Examiner erred in her factual findings concerning the scope and content of the prior art and its differences as compared with the claimed subject matter; lacks proper factual foundation for the modification of the prior art proposed to arrive at the claimed subject matter; and lacks proper articulated reasoning with cogent rationale to support the finding of obviousness. The foregoing errors resulted in an improper conclusion of obviousness. Claims 1-7, 11-22, 31 and 32 are not rendered obvious by Snyder, Risen, Petruzzi and Rivette and the Final Rejection dated September 15, 2008, should be overturned.

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Harness, Dickey & Pierce, PLC
P.O. Box 828
Bloomfield Hills, MI 48303
(248) 641-1600

Respectfully submitted,



Gregory A. Stobbs
Reg. No. 28,764